

Docket No. F-8309

Ser. No. 10/502,303

REMARKS

Claims 1-4 remain pending in this application. Claims 1-4 are rejected. Claims 5-15 are cancelled herein. Claims 1-4 are amended herein to clarify the invention. For the convenience of the Examiner, APPENDIX 1 is provided herewith having a complete set of pending claims with all amendments effected therein.

TITLE OBJECTION

The title is objected to in the Office Action as being nondescriptive. The title is amended to read "BATTERY PACK HAVING CIRCUIT SUBSTRATE RESIN MOLDED TO BATTERY" to overcome this objection. It is respectfully submitted that the amended title is sufficiently descriptive. Applicant respectfully requests that the objection to the title be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 2-4 are rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of informalities stated in the Office Action. The claims are amended to remove or correct the informalities noted in the Office

Docket No. F-8309

Ser. No. 10/502,303

Action. The phrase "tube-like" is now amended to read "tube shaped." The term "intermediate product" is now replaced with the phrase "substrate and battery assembly" whose meaning is self explanatory in the context of the claim. Therefore, reconsideration of the rejection of claims 2-4 and their allowance are earnestly requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by the JP '483 reference (JP2000-215483). Applicant herein respectfully traverses these rejections. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). It is respectfully submitted that the cited reference is deficient with regard to the following.

Claim 1 now recites the following feature nowhere disclosed in the '483 reference:

a molded resin member covering at least a portion of said first substrate and at least having an opening exposing a terminal surface of said terminal contact to outside said battery through said opening.

Furthermore, claim 1 recites the feature of:

Docket No. F-8309

Ser. No. 10/502,303

said substrate being united to said rechargeable battery by solidified molded resin molded between at least said second substrate side surface and said rechargeable battery to adhere said substrate to said rechargeable battery[.]

Such a combination of features is clearly absent from the '483 reference.

The Examiner contends that a resin shaped section 29 of the the'483 reference includes openings through which terminals 6, 7 are exposed to the outside." This is clearly not the case as "terminals" 6 and 7 are contact pieces which are covered by the molded resin piece and thus not exposed outside. There is no surface of either of the terminal pieces 6 and 7 exposed after the molding process. See paragraph 29. Instead, it appears that all electrical connections are made via a cable 11 and connector 10. See Fig 4. This type of connection does not constitute the claimed exposed surface of a terminal contact disposed on the substrate which is exposed *through* an opening in the molded resin. contact connections through the cable do not constitute an exposed surface of a terminal contact that is disposed on the substrate.

Similarly claim 2 recites:

an upper molded resin member at least having an opening for exposing a surface of the terminal contact to outside the battery pack;

Docket No. F-8309

Ser. No. 10/502,303

in combination with the substrate being adhere to the sealing plate by a resin molded member. As stated above, such a combination of features is not taught by the '483 reference.

The Office Action further improperly cites a heat-shrink tube in rejecting claim 2. The present rejection is an anticipation rejection which requires that all features be presented assembled as claimed. The heat shrink tube 14 shown in Fig. 17 is a different embodiment than the previously relied upon embodiment of Figs. 1 and 4. Hence, two different embodiments of the reference are applied. By definition of anticipation, two different emodiments, even of the same reference, cannot together anticipate a claim because they do not teach all components assembled as claimed.. There is no heat shrink tube taught in the embodiment of Figs. 1-4. and ther is no suggestion of a need for such a tube in Figs. 1-4.

Accordingly, it is respectfully submitted that a *prima facie* case of obviousness is not established with regard to either the heat shrink tube or the resin upper resin molded member having the opening exposing a surface of a contact terminal.

With regard to claim 4, the rejection must also fail. Claim 4 recites:

the upper molded resin member and the lower molded resin member, and the connection pieces are integrally molded such that the connection pieces are bendable at right angles at hinges formed therewith.

Docket No. F-8309

Ser. No. 10/502,303

In rejecting the claim the Examiner states that Figs 4 and 9 show "[r]ight angles or 90° bent portions can also be appreciated at parts where the extended member joins the upper portion and the lower portion respectively." However, this has nothing to do with the claimed subject matter. The claims require that the connection pieces be "bendable," *not bent*, and require the structure of *hinges* for the bending. Nowhere in the '483 reference are hinges disclosed in the connection pieces envisioned by the Examiner.

In view of the above, it is respectfully submitted that claims 1-4 particularly describe and distinctly claim elements not disclosed in the cited reference. Therefore, reconsideration of the rejections of claims 1-4 and their allowance are respectfully requested.

Docket No. F-8309

Ser. No. 10/502.303

NO FEE DUE

No fee is believed due. If there is any fee due the USPTO is hereby authorized to charge such fee to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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